

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Marugan et al.	
Application No.: 10/605,671	
Filed: 10/16/2003	Group Art Unit: 1796
Title: Light Colored Polycarbonate Compositions and Methods	Examiner: Marc S. Zimmer
Attorney Docket No.: GEPL.P-077	

REPLY BRIEF FOR APPELLANT

This Reply Brief is filed in support of Applicants' Appeal from the rejection mailed on January 18, 2008, and in response to the Examiner's Answer mailed May 27, 2008. This Reply Brief addresses issues and arguments raised in the Examiner's Answer.

As a first matter, the Examiner is quite correct to assert that the present invention is premised upon a solution to unexpected problems and properties of specific three-component mixtures. These specific three-component mixtures and their unexpected problems and properties are not disclosed anywhere in Okumura.

Applicants also acknowledge the veracity of the Examiner's assertion that Okumura discloses that three-component articles can contain a PC-PDMS copolymer. Applicants note that they have never suggested that Okumura does not disclose three-component articles. Rather Applicants have stated and restate now that nowhere in Okumura is there a disclosure of a composition having the specific three components of the present claims and more specifically the amounts in which they are claimed. As such Okumura does not recognize the problems attributed to the combination of these three-components and therefore cannot provide a solution to the problem or guidance as to how solve it.

The Examiner maintains his incorrect assertion that Applicants are required to

somehow provide evidence in the form of additional/supplemental Examples proving the individual criticality of each limitations of the claims. *See* the paragraph spanning pages 11 and 12 of the Examiner's Answer. The Examiner's asserted requirement is incorrect because it takes the claims of the present application and breaks them up into their individual limitations for consideration in isolation from the balance of limitations of the considered claim.

As Applicants have detailed in their Appeal Brief, it is not relevant that the individual limitations of the claims are by themselves considered to be individually "critical limitations". Rather Applicants stated and resubmit that it is the combination of the individual limitations, as each are recited in the specifically considered claim, which is the "critical" feature of the claims. The variables include concentration ranges of the specified three components, TiO₂ coatings, and article thickness specifications are they interrelated to solve the problem. Stated differently, varying one of these variables will affect the value of the other variable required to provide the solution. Applicants' specification is replete with examples and disclosure showing the interrelatedness of these variables as claimed.¹

In an attempt to discredit Applicants' showings the Examiner portrays Applicants' argument as having a "disconnect somewhere" therein. *See* the first full paragraph on page 14 of the Examiner's Answer. The Examiner mischaracterizes the evidence provided in the Example section of the present invention and draws attention to "seemingly contradictory" entries in Tables 3 and 5, which he classifies as not being representative of the claimed invention. *See* the first partial paragraph and the first full paragraph on page 14 of the Examiner's Answer. He then concludes that Applicants must be able to and have failed, "to point to an outcome that they regard as being exemplary if the Examiner is to be able to interpret the data and determine what has, and has not, been established as a critical element of the invention." *Id.* Applicants question the purpose of this statement? Applicants have and continue to point to the desired outcome of increasing the flame performance of the articles having the three components. The examples which the Examiner classifies as "contradictory" are examples showing the relatedness

¹ Applicants note that at paragraph 42 of the present specification support for using on organic coating with the TiO₂ is provided. This supports relates, *inter alia*, to the dispersion properties within the composition.

of claimed variables and show one skilled in the art how they may go about adjusting the variables to achieve the Applicants' desired result (e.g. improving flame performance). The Examiner has never addressed this point.

The Examiner lastly chastises Applicants' citation of Okumura's examples, saying that "[d]isclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure". See the paragraph spanning pages 14 and 15 of the Examiner's Answer. Applicants agree and submit that while the citation of the above form paragraph is generally true, what Okumura is lacking is the **BROADER DISCLOSURE** itself. To the extent that Okumura discloses three or more component articles, there is NO suggestion of: incorporating the specific three components into a composition; the negative impact on flame performance of the resulting composition; and the solutions provided by the present invention. Instead, as the Examiner correctly notes, Okumura only teaches the superior benefits (including the enhanced flame performance of articles) of compositions containing PC-PDMS and only one of the other two components of the present claims (e.g. PC-PDMS and PC, or PC-PDMS and TiO_2).

Assuming arguendo that the Examiner has made a prima facie case for obviousness, which Applicants maintain he has not, then one would expect that when all three components are combined, in ANY of Okumura's disclosed ranges, that an article made from that composition would exhibit superior flame performance. Applicants have demonstrated through evidence provided in the Example Section of the present specification that this is simply not the case and that an article comprising the three-components within some of Okumura's disclosed ranges for each of the three components results in reduced flame performance contrary to the teachings of Okumura. Applicants have also found, demonstrated, and claimed solutions to this problem. These solutions carve out specifications for the above-outlined interrelated variables in that they can be altered in relation to one another to solve these problems and increase flame performance of resulting articles. These solutions can not be considered to be obvious.

Applicants resubmit all of the arguments and assertions made in their Appeal

Brief and further submit that for all of the foregoing reasons the 103 (a) rejections should be reversed and that all claims (i.e. 72-132) of this application are in form for allowance. Such action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Marina T. Larson", is written over a horizontal line.

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